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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,376	08/21/2003	Volker Stade	11349-18-999	8582
20583	7590	01/13/2005	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			HAWKINS, CHERYL N	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	10/646,376	STADE, VOLKER	
	Examiner	Art Unit	
	Cheryl N Hawkins	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 and 5-18 is/are allowed.
- 6) ☒ Claim(s) 19-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 19 recites the limitation "the cross-sectional dimension" in lines 13-14 of the claim. There is insufficient antecedent basis for this limitation in the claim.

3. Claim 24-26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 24 recites a hand-held device comprising a "guiding web" in line 14 of the claim and then goes on to recite "said at least one guiding web" in line 16 of the claim. For the purposes of examination, it will be assumed that "guiding web" in line 14 should read --at least one guiding web--.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Manusch et al. (US 6,105,650). As to Claim 19, Manusch et al. discloses a hand-held device for transferring a film (Figure 1, tape 7) from a backing tape (Figure 1, carrier tape 6) onto a substrate (Figure 1, substrate 8), the device comprising a housing in which a supply of the backing tape is arranged (column 5, lines 36-39); and an application member (Figure 1, applicator foot 3) projecting from the housing and having a shaft and at least a free end, a first application edge (Figures 1-3, application toe 4a) and a second application edge (Figures 1-3, application toe 4b), the backing tape being wound around the free end and the application edges of the application member and extending into the housing with tape sections at a lower longitudinal side of the application member facing the substrate during operation and at an upper longitudinal side of the application member opposite the lower longitudinal side; wherein the second application edge (Figure 2, application toe 4b) projects from the lower longitudinal side of the application member; the second application edge has a height greater than a cross-sectional dimension of the first application edge; and the second application edge has a wedge-shaped cross-sectional shape.

As to Claim 20, Manusch et al. discloses a hand-held device for transferring a film (Figure 1, tape 7) from a backing tape (Figure 1, carrier tape 6) onto a substrate (Figure 1, substrate 8), the device comprising a housing in which a supply of the backing tape is arranged (column 5, lines 36-39); and an application member (Figure 1, applicator foot 3) projecting from the housing and having a front end with a free end and at least a first application edge (Figures 1-3, application toe 4a) and a second application edge (Figures 1-3, application toe 4b), the backing tape being wound around the free end and the application edges of the application member and extending into the housing with tape sections at a lower longitudinal side of the application

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member facing the substrate during operation and at an upper longitudinal side opposite the lower longitudinal side; wherein the second application edge projects from the lower longitudinal side of the application member with a mid-central plane transverse to a mid-central plane of the first application edge; and the first and second application edges extend across approximately the entire width of the application member.

As to Claim 21, Manusch et al. discloses a hand-held device wherein the first and second application edges (Figures 1-3, applicator toes 4a and 4b) have mid-central planes enclosing an angle of approximately 90°.

6. Claims 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Manusch et al. (US 4,853,074). Manusch et al. discloses a hand-held device for transferring a film (Figure 3a, film 5a) from a backing tape (Figure 3a, carrier tape 5) onto a substrate (Figure 3a, substrate 17), the device comprising a housing in which a supply of the backing tape is arranged (column 6, lines 40-42); an application member (Figure 1, applicator element 4, applicator bar 14) projecting from the housing and having a front end with a free end and at least a first application edge (Figure 4b, pressure-application edge 14') and a second application edge (Figure 4d, heel edge 18), the backing tape being wound around the free end and the application edges of the application member and extending into the housing with tape sections at a lower longitudinal side of the application member facing the substrate during operation and at an upper longitudinal side of the application member opposite the lower longitudinal side; wherein the second application edge projects from the lower longitudinal side of the application member with a mid-central plane transverse to a mid-central plane of the first application edge; and the first and

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second application edges extend across approximately the entire width of the application member.

As to Claim 21, Manusch et al. discloses a hand-held device wherein the first and second application edges (Figure 4d, pressure-application edge 14' and heel edge 18) have mid-central planes enclosing an angle of approximately 90°.

As to Claim 22, Manusch et al. discloses a hand-held device wherein the housing (Figures 1 and 2, covers 2a and 2b) has a lower border and a bottom side; and the second application edge (Figure 4d, heel edge 18) extends beyond the lower border of the housing and the bottom side of the housing.

As to Claim 23, Manusch et al. discloses a hand-held device wherein the second application edge (Figure 4d, heel edge 18) is offset backwards in relation to the first application edge (Figure 4d, pressure-application edge 14') in a direction closer to the housing.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manusch et al. (US 4,853,074) in view of Huthmacher. Manusch et al. discloses a hand-held device for transferring a film (Figure 3a, film 5a) from a backing tape (Figure 3a, carrier tape 5) onto a substrate (Figure 3a, substrate 17), the device comprising a housing in which a supply of the

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backing tape is arranged (column 6, lines 40-42); an application member (Figure 1, applicator element 4, applicator bar 14) projecting from the housing and having a front end with a free end and at least a first application edge (Figure 4b, pressure-application edge 14') and a second application edge (Figure 4d, heel edge 18), the backing tape being wound around the free end and the application edges of the application member and extending into the housing with tape sections at a lower longitudinal side of the application member facing the substrate during operation and at an upper longitudinal side of the application member opposite the lower longitudinal side; wherein the second application edge projects from the lower longitudinal side of the application member and is offset backwards in relation to the first application edge in a direction closer to the housing. Manusch et al. does not disclose a hand-held device which includes a guiding web projecting backwards from a backside of the second application edge facing the housing on at least one side of the second application edge. It is well known and conventional in the tape dispenser art, as disclosed by Huthmacher (Figure 4, guiding webs 17), to provide a hand-held device for transferring a film with guiding webs projecting backwards from a backside of the application edge facing the housing on both sides of the application member such that the guiding webs have an inner side guiding the backing tape being wound around the application edge. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the second application edge of Manusch et al. to include guiding webs as suggested by Huthmacher to provide means for guiding the backing tape around the application edge; the use of guiding webs being well established in the art.

As to Claim 25, Manusch et al. does not disclose a hand-held device which includes a guiding web projecting from the upper longitudinal side of the application member on at least

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one side of the first application edge. It is well known and conventional in the tape dispenser art, as disclosed by Huthmacher (Figure 4, guiding webs 17), to provide a hand-held device for transferring a film with guiding webs projecting from the upper longitudinal side of the application member on at least one side of the application edge. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the first application edge of Manusch et al. to include guiding webs as suggested by Huthmacher to provide means for guiding the backing tape around the application edge; the use of guiding webs being well established in the art.

As to Claim 26, Manusch et al. does not disclose a hand-held device which includes a guiding web at each side of the first and second application edges. It is well known and conventional in the tape dispenser art, as disclosed by Huthmacher (Figure 4, guiding webs 17), to provide a hand-held device for transferring a film with guiding webs at each side of the application edge and having a distance therebetween which conforms to the width of the backing tape to form guiding surfaces for the backing tape. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the first and second application edges of Manusch et al. to include guiding webs as suggested by Huthmacher to provide means for guiding the backing tape around the application edge; the use of guiding webs being well established in the art.

Allowable Subject Matter

9. Claims 1-3 and 5-18 are allowed.

10. The following is a statement of reasons for the indication of allowable subject matter:

As to Claim 1, the prior art of record to Manusch et al. (US 6,105,650), Manusch et al. (US 4,853,074), and Kobayashi (JP 11-157290) discloses a hand-held device for transferring a film from a backing tape onto a substrate, the device comprising a housing in which a supply of the backing tape is arranged; an application member projecting from the housing and having a front end with a free end and at least a first application edge and a second application edge, the backing tape being wound around the free end and the application edges of the application member and extending into the housing with tape sections at a lower longitudinal side facing the substrate during operation and at an upper longitudinal side of the application member opposite the lower longitudinal side; wherein the second application edge projects from the lower longitudinal side of the application member. The prior art of record to Manusch (US 6,105,650), Manusch et al. (US 4,853,074), and Kobayashi (JP 11-157290) do not disclose or provide motivation for a hand-held device comprising a third application edge projecting from the lower longitudinal side of the second application member between the first application edge and the second application edge.

Response to Arguments

11. In response to the applicant's amendment to claim 1 which incorporates the allowable subject matter from claim 4, the rejections of claims 1-3 and 10-18 under 35 USC 102(b) and 35 USC 103(a) have been withdrawn and claims 1-3 and 5-18 have been allowed.

In response to the applicant's arguments that none of the references of record show or suggest a device as recited in claim 19 which has an application member with first and second edges such that the height of the second application edge is greater than a cross-sectional dimension of the first application edge or a shaft of the application member and that the second application edge has a wedge-shaped cross-sectional shape, the examiner disagrees. The examiner asserts that Manusch et al. discloses a device wherein the second application edge has a height at its center which greater than a cross-sectional dimension, i.e. the height at the front of the first application edge, and the second application edge has a wedge-shaped cross-sectional shape.

In response to the applicant's arguments that none of the cited references disclose a device wherein the second application edge projects from the lower longitudinal side of the application member with a mid-central plane transverse to a mid-central plane of the first application edge; and the first and second application edges extend across approximately the entire width of the application member, the examiner disagrees. The examiner asserts that Manusch et al. ('650) discloses a device wherein the second application edge projects from the lower longitudinal side of the application member with a mid-central plane, i.e. a plane horizontally cutting through the center of the second application edge, transverse to a mid-central plane, i.e. a plane vertically cutting through the center of the first application edge, of the first

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application edge; and the first and second application edges extend across approximately the entire width of the application member. Manusch et al. ('074) discloses a device wherein the second application edge projects from the lower longitudinal side of the application member with a mid-central plane, i.e. a plane horizontally cutting through the center of the second application edge, transverse to a mid-central plane, i.e. a plane vertically cutting through the center of the first application edge, of the first application edge; and the first and second application edges extend across approximately the entire width of the application member.

The applicant's arguments with respect to claim 24 that none of the cited references show or suggest a second application edge offset backwards in relation to a first application edge and having at least one guiding web as recited in claim 24 have been considered but are moot in view of the new ground(s) of rejection. The newly provided reference of Huthmacher provides evidence that the addition of guiding webs onto the sides of application edges for guiding a backing tape is a well established practice in the tape dispenser art.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl N Hawkins whose telephone number is (571) 272-1229. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A Fiorilla can be reached on (517) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cheryl N. Hawkins
January 9, 2005


CHRIS FIORILLA
SUPERVISORY PATENT EXAMINER
AU 1734